UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,198	01/16/2004	Nobuyuki Tonegawa	00862.023404.	4895

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EXAMINER
RILEY, MARCUS T

ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/758,198	TONEGAWA, NOBUYUKI
	Examiner	Art Unit	
	MARCUS T. RILEY	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 November 2010*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-11* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *16 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *07/09/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   This office action is responsive to applicant's remarks received on November 12, 2010.

Claims 1-11 remain pending.

Response to Arguments

2.   Applicant's arguments with respect to **claims 1-11**, filed on November 12, 2010 have

been considered but they are not persuasive.

A: Applicant's Remarks

For applicant's remarks "See Applicant Arguments/Remarks Made in an Amendment"

filed on November 12, 2010.

A: Examiner's Response

Applicant argues that the cited references either alone or in combination do not teach,

disclose or suggest registration unit configured to register both the application data and the print

data generated from the application data in a database with a specific index, wherein the

application data and the print data are associated with each other by the specific index.

Examiner understands Applicant's arguments but respectfully disagree. Nagashima '202

specifically states at Paragraph 0056-0063 that the client 100 includes a data control section 1070

with a printer driver and that this printer driver is a program that processes printing data

generated by an application or the like so that the printing data can be processed by a printer.

Furthermore, the data control section 1070 includes an information management database 1073

wherein the printer driver program stores and registers Registration Files A & B. Thus, Nagashima '202 discloses the registration unit at Fig. 2, #1073, configured to register both the application data and the print data, Fig. 2, Registration Files A&B, generated from the application data in a database, Fig. 2, Information Management DB, with a specific index wherein the application data and the print data are associated with each other by the specific index. For example, Figs. 6 & 7 are diagrams showing the structure of data stored in the registration file with the specific index 1-3 and etc. "Registration File ID" and "Produces Files ID" 1-3 and etc. are the specific index associated with Registration Files A&B. Therefore, Nagashima '202 discloses the Applicant's claimed invention. As a result, it is respectfully submitted that the present application is not in condition for allowance.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101" – publicly available at USPTO.GOV, "memorandum to examining corp").

The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be "tied" to another statutory category, the structure of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

4. **Claim(s) 10 & 11** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. **Claim 10** define *"a program which causes a computer to execute"* and **Claim 11** define *"a program stored on a computer readable medium"* embodying functional descriptive material. However, the claim does not define a "non-transitory" computer-readable medium or a "non-transitory" computer-readable memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on a "non-transitory computer-readable medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory (refer to "note"

below).   Any amendment to the claim should be commensurate with its corresponding

disclosure.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 1, 2 & 6-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nagashima '202 (US 2002/0122202 A1 hereinafter, Nagashima '202) in combination with

Baharav et al. (US 6,751,352 hereinafter, Baharav '352).

        Regarding claim 1; Nagashima '202 discloses an image processing apparatus (Fig. 1,

#1000) comprising: first input unit (Fig. 1, #1020) configured to input application data created by

predetermined application software (Fig. 3, Step S1, Paragraph 0059);

        second input unit (Fig. 1, #1030) configured to input print data (Fig. 3, Step S2, Paragraphs 0059-

0063);

        the print data being generated by converting the application data (i.e. The printer driver is a

program that processes printing data generated by an application or the like so that the printing data can be processed by a printer.

Paragraph 0056 & 0082);

        registration unit (Fig. 2, #1073) configured to register both the application data and the print

data (Fig. 2, Registration Files A&B) generated from the application data in a database (Fig. 2, Information

Management DB) with a specific index (Fig. 6 & 7 i.e. Fig. 6 & 7 are diagrams showing the structure of data stored in the registration file with the specific index 1-3 and etc. "Registration File ID" and "Produces Files ID" 1-3 and etc. are the specific index associated with Registration Files A&B. Paragraphs 0056-0063);

wherein the application data and the print data are associated with each other by the specific index (i.e. "Registration File ID" and "Produces Files ID" 1-3 and etc. are the specific index associated with Registration Files A&B. Paragraphs 0056-0063);

a transmitting unit (Fig. 1, Cover Sheet Generating Section 1072) configured to transmit data to an external apparatus (i.e. Cover Sheet Generating Section generates data to be transmitted to the printing apparatus 2000 or 3000. Page 4, Paragraph 0058);

a printing unit (Fig. 1, Printers 2000 or 3000) configured to print an image on a sheet based on the print data (i.e. Printing data is generated with a coversheet and the generated printing data is printed by the printing apparatus 2000 or is transmitted to the printing apparatus 3000. Page 4, Paragraph 0058);

designation unit (Fig. 1, Printer Driver of Data Control Section 1070 - Not Shown) configured to designate said transmitting unit or said printing unit as an output method of data (i.e. The printer driver sends data to a designated address. The printer driver is a program that processes printing data generated by an application or the like so that the printing data can be processed by a printer. Page 4, Paragraph 0056);

and a selecting unit (Fig. 3, Step S4) configured to select the application data, but not the print data, corresponding to the specific index input by said index input unit in a case where the specific index is input by said index input unit said transmitting unit is designated by said designation unit, and to select the print data, but not the application data, corresponding to the specific index input by said index input unit in a case where said printing unit is designated by said designation unit; and (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079);

a control unit (Fig. 1, Data Control Section 1070) configured to control said transmitting unit to transmit the application data when said selecting unit selects the application data, and to control said printing unit to print an image on a sheet based on the print data when said selecting unit selects the print data (i.e. Data Control Section 1070 controls Cover Sheet Generating Section 1072 that generates data to be transmitted to the printing apparatus 2000 or 3000. Page 4, Paragraph 0058; See also Fig. 3 Step S4 and Fig. 5 Steps S502 & S503, Page 6, Paragraph 0074).

Nagashima '202 as modified does not expressly disclose discloses a scanning unit configures to scan a printed material on which a predetermined code is printed index input unit configured to analyze the predetermined code, which is printed on the printed material, and to input the specific index corresponding to the analyzed predetermined code.

Baharav '352 discloses a scanning unit (Fig. 1, Scanner 40) configures to scan a printed material (Fig. 1, Hard Copy 38) on which a predetermined code (Fig. 1, "L1" on Hard copy 38) is printed (i.e. Scanner 40 scans the predetermined code "L1" on Hard copy 38. Column 3, line 62 thru Column 4, line 51).

index input unit (Fig. 1, Barcode System 10) configured to analyze the predetermined code, which is printed on the printed material, and to input the specific index corresponding to the analyzed predetermined code (i.e The scan engine 44 receives a hard copy (e.g., a hard copy 38 or 54 with a first VSBC (L1) or a second hard copy 56 with a second VSBC (L2)), generates an acquired version 48 (e.g. a scanned version) of the received hard copy, and provides the acquired version 48 to applications, such as decoding module 24. Column 3, line 62 thru Column 4, line 51);

Nagashima '202 and Baharav '352 are combinable because they are from same field of endeavor of image processing apparatuses (Baharav '352 at Fig.1).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Nagashima '202 by adding a scanning and

index input unit as taught by Baharav '352. The motivation for doing so would have been to

permit the scanning of data to be converted to readable form. Therefore, it would have been

obvious to combine Nagashima '202 with Baharav '352 to obtain the invention as specified in

claim 1.

Regarding claim 2; Nagashima '202 discloses wherein said printing unit prints an image

obtained by synthesizing the predetermined code and the print data input by said second input

unit (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079);

Regarding claim 6; Nagashima '202 discloses wherein when the output method

designated by said designation unit is printing by said printing unit (i.e. Data Control Section 1070

transmits data to printing apparatus 2000 or 3000 to be printed. Page 4, Paragraph 0058);

said selecting unit selects the print data and causes said printing unit to print an image

based on the print data (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079).

Regarding claim 7; Nagashima '202 discloses when the output method designated by

said designation unit is transmission by said transmission unit, said selecting unit causes said

transmission unit to transmit the application data (Fig. 3, Steps S1-Steps S7 i.e. Printing data is generated with a

coversheet and the generated printing data is printed by the printing apparatus 2000 or is transmitted to the printing apparatus

3000. Page 4, Paragraph 0058).

Regarding claim 8; Nagashima '202 discloses where the database is constructed by a

terminal connected via a network (i.e. Fig. 1 Communication Network 4000, Page 4, Paragraphs 0051-0054).

Regarding claim 9-11; Claims 9-11 contain substantially the same subject matter as

claim 1. Therefore, claim 9-11 are rejected on the same grounds as claim 1.

7.   **Claims 3-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima

'202 (US 2002/0122202 A1 hereinafter, Nagashima '202) in combination with Ett (US

5,227,893 hereinafter, Ett '893).

Regarding claim 3; Nagashima '202 as modified does not expressly disclose wherein

the predetermined code is expressed by a barcode.

Ett '893 discloses where the information representing the index is expressed by a barcode

(See Fig. 5 where Fig. 5 shows a flow diagram for the reception of a facsimile image which contains the indexing/routing

information in pseudo code bar form.).

Nagashima '202 and Ett '893 are combinable because they are from same field of

endeavor of image processing apparatuses (Ett '893 at *"Summary"*).

At the time of the invention, it would have been obvious to a person of ordinary skill in

the art to modify image processing unit as taught by Nagashima '202 by adding where the

information representing the index is expressed by a barcode as taught by Ett '893. The

motivation for doing so would have been to permit the embedding of data needed for indexing,

or further routing, within the image in machine readable form, which is transparent to the users.

Therefore, it would have been obvious to combine Nagashima '202 with Ett '893 to obtain the

invention as specified in claim 1.

Regarding claim 4; Ett '893 discloses where the predetermined code is expressed by a

character string (i.e. Fig. 3 shows a typical string of bar codes in code 39, with a start character 78, data characters 80, a

check data character 82, and a stop character 84. Column 6, lines 34-39).

Regarding claim 5; Ett '893 discloses where the predetermined code is expressed by each character spacing in a predetermined character string (i.e. Fig. 3 shows a typical string of bar codes in code 39, with a start character 78, data characters 80, a check data character 82, and a stop character 84. The start 78 and stop 84 characters are identical and contain information needed to define the widths of the bars and spaces in the ensuing code patterns. column 6, lines 34-39).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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